

### **Remarks**

The Official Action mailed July 11, 2005 has been given serious consideration, but applicants believe the invention as defined in new claims 58 through 101 complies with the formal requirements of the statute and is patentable over the teachings of the cited references.

Applicants have hereinabove cancelled without prejudice claims 1-57 and have added new claims 58-101. Applicants reserve the right to prosecute claims commensurate in scope to the subject matter of claims 1-57 in one or more later filed divisional and/or continuation applications. No new matter has been added by this amendment. Support for this amendment is found throughout the specification and will be discussed in more detail below. Upon entry of this amendment, new claims 58-101 will be pending.

### **The Invention**

As can be seen from the new claims submitted herewith, the invention comprises colorant compositions having very good properties *vis-à-vis* conventional technology, paints formed through utilization of such colorant compositions which also exhibit very good properties, and innovative copolymer surfactants that are particularly efficacious in formulating such colorant compositions and paints. Methods of making those colorant compositions and paints are also included in the invention.

More specifically, claims 58 through 77 are directed to colorant compositions which comprise at least one pigment, water, and a copolymer surfactant of the invention. The claims expressly prescribe that such copolymer surfactant, “when incorporated in a paint formed of a mixture comprising said composition and a tint base, causes the Stormer low-shear viscosity of said paint to be within  $\pm 10\%$  of the Stormer low-shear viscosity of said tint base.” For the purpose of simplicity, this property is referred to in this paper as “viscosity stabilization”. The

claim language finds support in the application: at page 4, line 30, to page 5, line 12; at page 19, line 3 to line 13; and in the paragraph bridging pages 21 and 22, as well as the following two paragraphs.

Correspondingly, claims 78 through 99 are directed to paints including a tint base, and a colorant composition containing at least one pigment, water, and a copolymer surfactant as aforesaid, or to methods for making such paints. These paints have good flow/leveling properties, as well as good gloss characteristics, due to their formulation utilizing the colorant compositions of the invention. In this connection, the Examiner's attention is invited to: page 5, lines 18-23; and page 21, line 23, to page 23, line 3.

Additionally, new claims 100 and 101 are directed to copolymer surfactants exhibiting particular efficacy in the making of the aforementioned colorant compositions and paints. The subject matter of claims 100 and 101 find support in the application: in the first full paragraph on page 7; at page 8, lines 14-16; at page 9, lines 24-28; at page 10, lines 32-33; at page 11, lines 5-9; in the paragraph bridging pages 11 and 12; and at page 27, lines 1-36.

### **Drawings**

A "Replacement Sheet" for the figure of drawing submitted with the original application is now enclosed as Exhibit A. The "Replacement Sheet" is endorsed with the designation "Fig. 1" and re-oriented so that it is not "upside down". Also, extraneous information identifying the application, as well as the designation "1/1" have been removed. Accordingly, it is believed that the objection to the initially submitted drawing is obviated, and its withdrawal is requested.

**Formal Rejection**

The Examiner's rejection of claims 1, 14, 15, 18-25 and 34-57 under 35 U.S.C. 112, second paragraph, for alleged indefiniteness is believed inapplicable to the newly presented claims.

First, original claim 1 has been cancelled, and accordingly the Section 112 rejection involving it is therefore mooted.

Concerning the contention that claims reciting "a tint base" are defective because that term "has not been clearly defined and causes confusion since it is not made clear what is included in a tint base", the application is urged to contain ample instruction as to the term's meaning. Apart from the fact that applicants believe "tint base" to be a term known to those of ordinary skill in the art, its import is clear from the disclosure at page 21, lines 23-26, page 32, lines 32-33, page 33, Table 7, and page 33, line 35, to page 34, line 5. Thus, at page 21 it is taught that both latex particles and "associative rheology modifiers" can be present in the tint base as contemplated in the application. At pages 32 through 34 it is taught that the tint base can contain various dispersants, surfactants and thickeners, along with "calcium carbonate" which is the Examiner herself characterizes as a pigment in the Official Action, page 5, paragraph 4. Evidently, the application teaches that the tint base can include conventional additional ingredients "like surfactants, associative thickeners, other pigments" (see Examiner's inquiry in the Official Action, page 3, paragraph 2), with the result that "tint base" is a sufficiently definite expression for inclusion in the claim language.

As to the Examiner's questioning of the phrase "does not substantially change color after rub-up" for recitation of "substantially", it is urged that this word has long been recognized in the law as adequately definite. In re Mattison, 509 F.2d 563, 565 (CCPA 1975). See also Musher

Foundation v. Alba Trading Co., 150 F.2d 885, 888-89 (2d Cir. 1945), (Hand, L.) *cert denied*, 326 U.S. 770 (1945). Accordingly, this criticism is unwarranted.

In respect of the Examiner's contention that "low-shear viscosity" and "high-shear viscosity" render the claim language "indefinite", because the specification "does not provide a standard for ascertaining" what constitutes "low-shear" and "high-shear", is also unwarranted. The Examiner's attention is invited to the fact that the language of the new claims recites - not just "low-shear viscosity" and "high-shear viscosity" - but "Stormer low-shear viscosity" and "ICI high-shear viscosity". At page 34 of the application, it is disclosed that such viscosity parameters are determined according to ASTM Standards D562-01 and D4287-00, respectively. These ASTM Standards are known to those of ordinary skill in the art, and it follows that reference to "Stormer low-shear viscosity" and "ICI high-shear viscosity" is sufficiently definite to satisfy Section 112.

Therefore, it is requested that the rejection of the claim language under 35 U.S.C.112 be withdrawn and not applied to the new claims.

#### **Prior Art Rejections**

It is further urged that rejection of new claims 58 through 101 based on the patents cited by the Examiner is unjustified. The teachings of the cited patents are simply inadequate to anticipate the claimed subject matter, or to have made it obvious to one of ordinary skill in the art.

With reference to claims 58 through 77 directed to colorant compositions or methods of making same, applicants are unable to find in any of the Sonnabend, Hawe *et al* and Chang *et al* patents a teaching that the copolymer surfactant monomer prescribed by applicant's new claim language be incorporated in a colorant composition. Furthermore, each of those patents is (as far

as applicant can see) devoid of any teaching that a colorant composition in accordance with the invention will exhibit a viscosity stabilization effect. Even U.S. Patent No. 5,770,760 cited by applicant at page 3 of the application (though not applied by the Examiner), and related U.S. Patent No. 5,874,495 (a division of the '760 Patent), which disclose the tristyrylphenylpoly(ethyleneoxy) methacrylate monomer recited in certain of applicant's claims, are devoid of any teaching that applicant's copolymer surfactant should be incorporated in a colorant composition. Those latter patents are also devoid of any teaching that the colorant composition exhibits a "viscosity stabilization" effect. It follows that none of the patents in question is adequate to teach within its "four corners" all of the elements specified in claims 58 through 77. Furthermore, one of ordinary skill in the art would not have had any motivation to modify the teachings of the patents in question (or for that matter the Carpenter *et al* patent cited by the Examiner on page 8 of the Official Action) so as to devise a colorant composition with a "viscosity stabilization" effect as defined in claims 58 through 77. Certainly, there is no such express instruction in the patents. Nor would such practice have been inherent in their prescriptions. The Examiner's contention that "such properties are evidently dependent upon the nature of the composition used" (Official Action page 7) does not establish that there is any teaching in any of the aforementioned patents which would have led one of ordinary skill in the art to formulate a colorant composition inevitably exhibiting "viscosity stabilization" as specified in the claims, the standard which must be met to establish inherency. The Spada case relied upon by the Examiner is inapposite, as the rubric "that a material and its properties are inseparable" falls fatally short of remedying the problem that no embodiment fairly taught by the aforementioned patents would have inevitably led one of ordinary skill in the art to colorant compositions having the "viscosity stabilization" effect required by claims 58 through 77.

Similarly, the paints and methods of making same defined in claims 78 through 99 are also clear of any teaching in those patents. Since the claims require that such paints be made using colorant compositions which are patentable, as established above, the paints must also be patentable, as well as the methods of making them. Moreover, and in any event, the particular paints defined in applicants' claims have highly advantageous flow/leveling properties and gloss characteristics. Nothing in the patents in question explicitly discloses all of the elements prescribed in claims 78 through 99. Nor is there any disclosure that use of colorant compositions containing copolymer surfactants as defined in those claims would yield paints having such desirable properties and characteristics. Accordingly, for the reasons set forth above, it is submitted that the practice of applicants' invention as defined in claims 78 through 99 neither is anticipated nor would have been made obvious by express teachings of the patents or things inherent therein.

Lastly, it is noted that new claims 100 and 101 are drawn to a narrow set of copolymer surfactants particularly useful in formulating colorant compositions and paints according to applicants' invention. It is believed that none of the aforementioned patents - all of which are devoid of "viscosity stabilization" teachings - would have motivated one of ordinary skill in the art to fashion any of the copolymer surfactants now covered by claims 100 and 101. That is, nothing in the very broad disclosures of the patents in question would have caused one of ordinary skill in the art to select the specific monomers specified in claims 100 and 101 for the purpose of producing copolymer surfactants capable of "viscosity stabilization" as required by such claims. Therefore, it is believed that the patent teachings are in the nature of a "shot gun disclosure" and are inadequate to anticipate or to have made obvious applicant's claimed copolymer surfactants. See In re Kalm, 378 F.2d 959, 962 (CCPA 1967).

In view of the foregoing, it is requested that the Section 102/103 rejections be withdrawn and not applied to new claims 58 through 101.

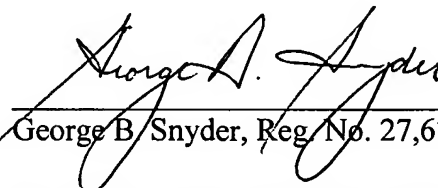
**Conclusion**

Therefore, entry and allowance of new claims 58 through 101 are requested.

Respectfully submitted,

Dated: October 11, 2005

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